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EXAMINER

WILLETT, STEPHAN F

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 03/15/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

PM

Office Action Summary

Application No.

09/726,912

Applicant(s)

ISAACS ET AL.

Examiner

Stephan F Willett

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Allowable Subject Matter

1. Claims 2-3, 5-7, 10, 15, 19-20 are objected to as being dependent upon a objected/rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the "contacts user/contact relationships" and is unclear. Claim 17 is recites the limitation "the electronic message" instead of an electronic message . There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC 102

4. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-2, 8-9, 11, 13-14, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Helfman et al. with Patent Number 6,396,513.

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6. Regarding claim(s) 1, Helfman teaches accessing a plurality of messages, col. 2, lines 55-57. Helfman teaches processing messages, col. 2, lines 57-60. Helfman teaches determining the identity of user contacts, col. 3, lines 3-4. Helfman teaches assigning rankings or relative importance to contacts, col. 3, lines 59-60. Helfman teaches determining a relationship between user and contacts as “sender” and “destination”, col. 2, lines 37-38, Boolean relations, col. 7, lines 6-9, “patterns”, col. 7, line 18, “contents of any mailbox”, col. 7, lines 21-22, and “family matters” designation, col. 7, lines 48-50, etc.

7. Regarding claim(s) 4, 16, Helfman teaches email messages, col. 1, lines 66-67.

8. Regarding claim(s) 8-9, 13-14, Helfman teaches a relationship between contacts as a “pattern” based on a “rule”, col. 7, lines 18-20 and Boolean relations between words, col. 7, lines 6-9 in fields such as headers or subject, col. 2, line 39.

9. Regarding claim(s) 17, Helfman teaches email is identified by the user, col. 2, lines 64-65.

10. Regarding claim(s) 18, Helfman teaches receiving user approval of contacts and their priority as based “on criteria under the control of the user, col. 4, lines 28-29.

11. Claims 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Scannell et al. with Patent Number 5,377,354.

12. Regarding claim(s) 11, Scannell et al. teaches receiving files as “messages”, col. 3, lines 37-39 which include contacts as senders, col. 5, line 22. Scannell teaches reviewing the files to determine contacts, col. 7, lines 38-39, priorities, col. 8, line 16 and relations as sender versus

address, col. 5, line 42. Scannell teaches providing an analysis of the relative importance of contacts to one another, col. 6, lines 9-12, 65 and relations between contacts, col. 6, lines 43-45.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable Scannell et al. with Patent Number 5,377,354 in view of Aronson et al. with Patent Number 6,654,787..

15. Regarding claim(s) 12, Scannell et al. teaches receiving files as “messages”, col. 3, lines 37-39 which include contacts as senders, col. 5, line 22. Scannell teaches reviewing the files to determine contacts, col. 7, lines 38-39, priorities, col. 8, line 16 and relations as sender versus address, col. 5, line 42. Scannell teaches providing an analysis of the relative importance of contacts to one another, col. 6, lines 9-12, 65 and relations between contacts, col. 6, lines 43-45. Scannell teaches the invention in the above claim(s) except for explicitly teaching determining whether files are unsolicited or spam. In that Scannell operates to categorize data in a computer network, the artisan would have looked to the network data management arts for details of implementing other type of data identification. In that art, Aronson, a related network data referral communication system, teaches “filtering of electronic mail”, col. 1, line 8 in order to provide relevant email. Aronson specifically teaches “spam probes”, col. 4, line 49. Further,

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Aronson suggests "an anti-spam system", col. 2, lines 9-10 which will result from implementing the email filtering. The motivation to incorporate unsolicited email detection insures files are routed accurately. Thus, it would have been obvious to one of ordinary skill in the art to incorporate unsolicited email detection as taught in Aronson into the communication system described in Scannell because Scannell operates with email type detection and Aronson suggests that optimization can be obtained by specifically detecting unsolicited email. Therefore, by the above rationale, the above claims are rejected.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. The other references cited teach numerous other ways to perform network access referrals, thus a close review of them is suggested.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

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Stephan Willett

A handwritten signature in black ink, appearing to read "Stephan Willett", written in a cursive style.

Patent Examiner

February 18, 2004